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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/067,662 | 02/04/2002 | Alvin J. Glasky | 370143.100 | 8319 |

7590

03/29/2005

ATTN: Louis C. Cullman
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EXAMINER

JIANG, SHAOJIA A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,662

Applicant(s)

GLASKY ET AL.

Examiner

Shaojia A. Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/10/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on December 10, 2004 wherein claim 36 has been amended. Claims 1-34 have been cancelled previously.

Currently, claims 35-40 are pending in this application.

Claims 35-40 are examined on the merits herein.

This application is a CON of 08/878,656 06/19/1997 PAT 6,350,752 which is a CON of 08/492,929 07/20/1995 ABN, which is a CIP of 08/488,976 06/08/1995 PAT 5,801,184, which is a CIP of 08/280,719 07/25/1994 PAT 5,447,939.

The terminal disclaimer filed on December 10, 2004, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 5,801,184 and 5,447,939 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Therefore, the obviousness-type double patenting rejections of record in the previous Office Action July 29, 2004, as being unpatentable over U.S. 5,801,184 and 5,447,939 are withdrawn.

Applicant's amendment changing the limitation to the single specific compound herein in the claims filed December 10, 2004 with respect to the rejection of claims 35-40 made under 35 U.S.C. 102(b) as being anticipated by Sham et al. of record stated in

the Office Action dated July 29, 2004 has been considered and found persuasive to remove this particular rejection. Therefore, the said rejection is withdrawn.

The following is new rejection(s) necessitated by Applicant's amendment filed December 10, 2004.

Moreover, the following is new rejections necessitated by Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on December 10, 2004.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Glasky, Alvin J. (WO 91/14434 published 10/3/1991, equivalent to US 5091432, PTO-1449 submitted 12/10/2004).

Glasky discloses that administering to a mammal, the specific carbon monoxide dependent guanylyl cyclase modulating purine derivative, 4-[[3-(1,6-dihydro-6-oxo-9H-purin-9-yl)-1-oxopropyl]amino]- benzoic acid (also known as AIT 082 acid, see col.8 line 48-51; col.45, the 2nd last compound), is useful in a method for treating neuroimmunologic disorders or neurological disorders such as in mammals such as

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Alzheimer's disease (see abstract; col.2 line 35-65; col.4 line 1-9 and 50-52; claim 8 in particular). Glasky discloses that the effective amounts or doses of the specific carbon monoxide dependent guanylyl cyclase modulating purine derivative, 4-[[3-(1,6-dihydro-6-oxo-9H-purin-9-yl)-1-oxopropyl]amino]- benzoic acid, produces a treating concentration of at least 1 μ M (see Table 1-5 at col.31-33). Glasky discloses that the said mammal is treated by orally administering or injecting the compound such as AIT 082 (see col.4 line 50-52).

Therefore, Glasky anticipates Claims 35-40.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on December 10, 2004 prompted the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

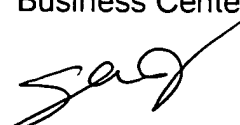
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Anna Jiang, Ph.D.
Primary Examiner
Art Unit 1617
March 10, 2005